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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,748	11/20/2006	Morten Rise Hansen	3605	2867
21834 7590 08/12/2010 BECK AND TYSSER P.L.L.C. 2900 THOMAS AVENUE SOUTH SUITE 100 MINNEAPOLIS, MN 55416				
EXAMINER				
FORTUNA, JOSE A				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
08/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,748

Applicant(s)

HANSEN, MORTEN RISE

Examiner

José A. Fortuna

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite, because a broad range or limitation followed by linking terms (e.g., preferably, maybe, for instance, especially, *in particular*) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

In claim 21 the phrase "according to a standardized method," renders the claim indefinite, as to what is the standard used to measure the properties. Note that the standards can vary in the future and therefore, the metes and bounds of patent protection desired cannot be ascertained.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt et al., US Patent No. 6,893,525.

Schmidt et al. teach a method of making a dry-laid web, i.e., air laid, in which papermaking fibers are deposited onto a foraminous belt/fabric with low moisture content, i.e., air laying technique, then the web is pressurized and embossed and then a latex binder is added to either one surface of the formed web or to both surfaces of the web and then the binder is cured to bond the fibers, see column 4, line 45 through column 5, line 8. Schmidt et al. teach that such sequence of steps is very common in the art and it is called, pre-embossing process, which is as its name indicates the embossing is done prior to the bonding of it, which is opposed to the post-embossing technique in which the bonding is done prior to the embossing, see column 1, lines 28-33, see also US Patent No. 4,476,078. Schmidt et al. teach the formation of webs with grammage in the claimed range, i.e., overlapping grammage, see column 5, lines 56-62, i.e., they disclose basis weight between 25 to 400 pounds per 3000 ft², (converts to about 40 to about 651 g/m²). They also teach the use of super absorbent polymers, column 6, lines 14-22 and teach that the air laid webs can be made by the methods of US Patent No. 5,128,082 which is

incorporated by reference and such reference teaches that the SAP can be either added to the fibers or added to the consolidated web, see column 5, lines 7-26. Schmidt et al. teach that the binder, which is preferably latex, is sprayed onto the web and it is well known that when latex is sprayed, the latex is an very diluted aqueous solution, i.e. greater than 90% water, so that the binder particles do not clog the spraying nozzles¹. Schmidt et al. teach also the use of vacuum to assist the penetration of the latex into the fibers, see figure 1, stations 42 and 48 and better explained in the US Patent No. 5,128,082 which was incorporated by reference. Even though Schmidt et al. do not explicitly teach the lineal pressure², they incorporated by reference the teachings of US patent No. 4,612,231, and this patent shows that it is common to consolidate the web at lineal pressure between 50 to 300 lbs/lineal inch, see column 5, lines 59-63 of the mentioned patent, such range overlapping the claimed range. As to the configuration of the embossing rolls, Schmidt et al. teach that it is preferred for the roll to have sinusoidal configurations, with raised bosses, i.e., tooth bosses, see column 8, lines 33-63.

Schmidt et al. clearly teach, see paragraph bridging columns 5 and 6, that the web comprises essentially cellulosic fibers, see column 5, lines 59-63, and that synthetic fibers could be used. Even though Schmidt et al. do not explicitly teach the claimed property, i.e., the dust due to fluff, this property must be inherent to the produced web, since they are made using the same ingredients, i.e., raw materials, and using the same process of making. It has been held that “Where the claimed and prior art apparatus or product is

¹ See US 5,824,191 see examples or US Patent Application Publication No. 2005/0045295, see ¶-[0102]-[0104], Just to mention a couple.

² Since it is not known what exerts this pressure, i.e., the consolidation pressure or the embossing pressure, for the purpose of this action, it would be considered the consolidation pressure.

identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure or product recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

Note that claim 21 has been rewritten as a product by process claim and the web of the cited reference, as explained *supra*, seem to be the same as the one claimed. In the event any differences can be shown for the product -by-process claim 1 as opposed to the product taught by the reference Schmidt et al. such differences would have been obvious to one of ordinary skill in the art as routine modification of the product in the absence of a showing unexpected results, see *In re Thorpe*, 227 USPQ 964 (CAFC 1985). As the afore mentioned claims are product by process claims, it is deemed that "[A]ny difference imparted by the product by process claims would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicants to establish that their product is patentably distinct, ..." *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Further, "[P]rocess limitations are significant only to the extent that they distinguish the claimed product over the prior art product." *In re Luck*, 177 U.S.P.Q. 523 (1973).

Response to Arguments

5. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew J. Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF